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EXAMINER	
BROCKETTI, JULIE K	

ART UNIT	PAPER NUMBER
3713	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/077,041	STERN, MAX	
	Examiner	Art Unit	
	Julie K Brocketti	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 March 2004* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6,7 and 9-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6,7 and 9-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Objections

Claims 9-13 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 9-13 are each independent claims and must be written as such and the appropriate fees for the claims must be paid. By claiming a separate apparatus, i.e. a device, that performs the method of a method claim, method claim is not being further limited as to be a dependent claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 6, 7 and 9-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 states "...COMBINED of the above; and..." and claims 14 and 19 state "...matching elements IN ORDER, in DISORDER, or COMBINED..." claim 21 states "...is to match elements in COMBINED". These phrases are

confusing and it is unclear exactly what the "COMBINED style" is and how much of the "above" claim language it includes. It would be clearer if one clearly stated that the COMBINED style includes matching elements IN ORDER and matching elements in DISORDER.

Claims 11-13 all sates "A game according to the method of claim..." It is unclear as to what applicant is attempting to claim is "the game" a method of playing the game or an apparatus for playing the game. By just saying "A game according to the method of..." It is not clear exactly what applicant is attempting to claim. Furthermore, as stated above, these claims do not further limit the subject matter of a previous claim and need to be rewritten in independent form.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, 6, 7, 9-14, 16, 17 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Travis et al., U.S. Patent No. 5,380,007 in view of the DC Lottery's "DC Lucky Numbers". Travis et al. discloses a gaming device and method for playing a game. The game is a slot machine and

includes game initiating means to initiate a game on the machine (col. 2 lines 7-9). A display means is disposed to display the game being played on the machine. The display means is arranged to display a plurality of elements having indicia each associated with a symbol. The machine further includes buttons indicating grid reference on the display so that indicia positions may be selected by pressing the buttons (Fig. 4; col. 2 lines 3-5; col. 3 lines 41-50). The display is an electromechanical device (Fig. 1; col. 2 lines 32-34). The game has a game controller, which provides a first set of contest elements having a surface area with playing indicia on the surface area. The game controller displays all elements of a first set of contest elements to a player of the game. The player is then permitted to select a plurality of elements from the first set of elements for game play (col. 2 lines 3-5). A table of values is established for matching the selected contest elements based on the number of elements selected (col. 3 lines 51-54). The controller then provides a sufficient number of additional sets of contest elements. The additional number of sets is equal to the number of elements selected by the player for play of the game and each additional set is identical to the first set of elements. The controller then randomly selects one element from each of the additional sets of elements and compares the randomly selected elements to a user selected contest elements obtained. The controller then evaluates the number of matched contest elements selected by the player against the table of values (Fig. 3; col. 7 lines 23-41). The number of contest elements in the first set is at least ten and

the player selects at least two elements from the first set of contest elements. The player selects no more than eight elements form the first set of contest elements (Fig. 1). The game controller is an electronic video game machine, i.e. a computer. Players may place a wager on each possible matching outcome. If the player has a winning combination of contest elements as determined by the table of values according to the player's wager, the player is paid an award. The game has an electronic system for playing a slot machine game and has a plurality of play options wherein a win or a loss is determined after each play of the game. The system includes a game enclosure, including a player interface means for a player to physically interact with the system. A bet value entry means is used for generating a bet value signal to the system representing an amount of a bet placed by a player (col. 4 lines 35-50). Player display means visually indicates to the player a set of elements having indicia thereon. Player selection means allows the player to select a plurality of elements from the set of elements (col. 4 lines 53-55). A game control means is responsive to the player selection means wherein control means randomly selects from the set of elements having indicia thereon equal to a number of elements (Fig. 1). A processor compares the indicia on the player selected elements to the indicia on the randomly selected elements and awards a prize to the player in the event that one or more of the user selected elements matches the randomly selected elements (Fig. 6). The processor means is electrically connected to the player display means, the player selection means, the bet value entry means

and to the game control means (Fig. 1). Travis et al. discloses all of the limitations mentioned above including that the game controller is an electronic video game machine, i.e. a computer. It would have been obvious at the time the invention was made that the game controller can be selected from the group consisting of electronic video game machines, mechanical game machines, computers, hand-held mechanical devices and hand-held video devices. All of these types of machines are well known in the art and are capable of implementing the game method described in Travis et al. It is up to the inventor's discretion which game machine to use. Players enjoy all types of gaming machines and by implanting the method of Travis et al. on various machines; more players would be interested in the game.

Travis lacks in disclosing that the player select the style of the game including matching elements IN ORDER, in DISORDER or a COMBINATION of elements in order and in disorder. The DC Lottery's game "DC Lucky Numbers" allows players to select the style of a game for matching contest elements, i.e. numbers. The style is selected form the group consisting of matching elements IN ORDER; matching elements in DISORDER and a COMBINATION of elements in ORDER and DISORDER. A player places a wager on each possible matching outcome according to the style of the game selected. A table of values is established for a plurality of elements based on the selected contest numbers, the number of elements selected and the style of the game selected (See "DC Lucky Numbers"). For example, a player may select

the style of game to play, either straight (IN ORDER), box (DISORDER), straight/box, combo, front pair (COMBINATION) or back pair (COMBINATION) and are awarded different amounts based on which game style they selected to play. The player may repeat the selection of any element as often as desired up to the limit of the number of elements to be selected only if the style of game is to match elements IN ORDER. For example, the player may wish to play more than one game using an Advance Play feature wherein their bet is repeated. It is obvious that the number of wagers could be equal to the number of elements selected when the style of game is to match elements IN ORDER, the number of wagers could be equal to one or more than the number of elements selected when the style of game is to match elements in DISORDER and the number of wagers could be equal to two or more than the number of elements selected when the style of game is to match elements in COMBINED. DC Lottery teaches of a variety of wagering styles and it would have been obvious to one of ordinary skill in the art to implement any type of wagering style that is profitable to lottery. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the game styles and wagering of "DC Lucky Numbers" into the lottery gaming device of Travis. Lottery players enjoy selecting their numbers and the types of combinations that are winners, i.e. straight, box, etc. Therefore, by allowing the gaming players of Travis to select the style of the game they wish to play,

players would have a more enjoyable gaming experience because they have more control over what types of combinations they are wagering on.

Claims 15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Travis et al., in view of "DC Lucky Numbers" in further view of Morro et al., U.S. Patent No. 5,947,820. Travis et al. lacks in disclosing a touch sensitive screen and a set of rotatable reels. Morro et al. discloses an electronic game in which the display means comprises a touch sensitive video screen and the player selects indicia by touching areas on the screen in which the indicia are displayed (See Morro et al. col. 3 lines 43-48). The display means further comprises a set of rotatable reels (See Morro et al. Fig. 2). It would have been obvious at the time the invention was made to use a touch screen display in the invention of Travis et al. Touch screens are well known in the art and allow the player to directly touch the item they wish to select. It simplifies the selection process for the player and they do not need to learn how various buttons operate. It would also have been obvious at the time the invention was made to use rotatable reels in the invention of Travis et al. Many games use rotatable reels to simulate the selection of a random number or symbol. Players have enjoyed games with rotatable reels throughout the years and it is obvious to implement this display method in Travis et al. in order to appeal to those players who enjoy rotatable reel games.

Response to Amendment

It has been noted that claims 1-4, 6, 7, 9, 14 and 19 have been amended. New claims 20 and 21 have been added. Claims 5 and 8 have been cancelled.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

The Examiner agrees that Travis did not show the amended claim limitations therefore, the reference "DC Lucky Numbers" has been added to show that the limitations are obvious.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH

shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K Brocketti whose telephone number is 703-308-7306. The examiner can normally be reached on M-Th 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on 703-308-1327. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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